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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/038,766	01/02/2002	Jeffery Tabor	659/919	6310
7590 10/06/2003				
Robert N. Carpenter BRINKS HOFER GILSON & LIONE P.O. BOX 10395 CHICAGO, IL 60610			EXAMINER PURVIS, SUE A	
			ART UNIT 1734	PAPER NUMBER

DATE MAILED: 10/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/038,766

Applicant(s)

TABOR ET AL.

Examiner

Sue A. Purvis

Art Unit

1734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 May 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 17-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 17 introduces a 'second substrate web' in the preamble, but fails to mention it again within the body of the claim. The claim discloses a 'substrate web' onto which discrete parts are applied. Claims 19 and 20 mention the 'second substrate web' and claim 20 states that discrete parts are applied to the 'second substrate web'. Clarification is required.

3. Claim 19 recites the limitation "said first substrate web" in lines 2 and 3. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit: 1734

5. Claims 1, 2, 4-6, and 9-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Schroth et al. (US Patent No. 4,608,115).

Schroth discloses a revolving transfer roll with a carrier bodies in the form of rotatable platen means (32). The platen includes a generally concave portion on its surface in the form of rectangular grooves (116, 118). The device is capable of engaging parts of differing thickness. (Col. 5, lines 27-51; Figures 4 and 6.)

Regarding claim 2, the recessed portions (116, 118) are located generally centrally as shown in Figure 4.

Regarding claim 4, the recessed portions are generally rectangular as shown in Figure 4.

Regarding claim 5, the platen includes vacuum passages (74) for communication to a vacuum source.

Regarding claim 6, the platens (32) are supported on the vacuum plates (78) of the roll (4).

Regarding claims 9, 10, 15, and 16, Schroth, described above, also includes a web supply (20) for continuously feeding a material (22) to the transfer roll. The roll supports the rotatable platens (32), and as described above the platens are considered to have a generally concave shape. (Col. 4, lines 41-57.)

Regarding claim 11, the web conveyor and the transfer assembly are capable of being spaced apart a distance less than the combined total thickness of the substrate web and the discrete part to ensure the discrete part contact the web as the transfer assembly rotates.

Art Unit: 1734

Regarding claims 12-14, Schroth includes an applicator means (8) with striking members (60, 61) which cause at least 95% of the surface of the discrete part to contact the web material (22).

6. Claims 1 and 3 are rejected under 35 U.S.C. 102(b) as being anticipated by Buell (US Patent No. 4,081,301).

Buell discloses a carrier body (23) with a generally concave outer surface in an hour-glass shape. The body is capable of engaging parts of differing thickness. (Col. 6, lines 34-45.)

7. Claims 17-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Oshefsky et al. (US Patent No. 4,578,133).

Oshefsky discloses a web (24a) conveyor with a rotating transfer assembly (36) with transfer means (30) for transferring elastics (16, 18). The transfer means include flexible strip supports (32) to which the self-adhering elastic strip material will adhere sufficiently for purposes of the invention and from which the elastic strips can be removed for transfer to web of material as described below. Alternatively, Oshefsky discloses that other suitable methods may be employed to temporarily adhere the elastic strips to the flexible strip supports, such as a vacuum which may be supplied to openings on the top surface of flexible strip supports (32) to hold the elastic strips in place. If a vacuum were used, the openings discussed would amount to a recessed portion. The embodiment of Figure 5B shows the transfer members rotating about a second axis. The pivoting supports (48) are adapted to move along a curvilinear path on a cam track (60). (Col. 7, lines 25-55; Col. 9, lines 3-65.)

Regarding claims 18 and 19, the device in Oshefsky is capable of maintaining a constant speed. Intended use recitations and other types of functional language cannot be entirely

Art Unit: 1734

disregarded. However, in apparatus claims, intended use must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967); *In re Otto*, 312 F.2d 937, 938, 136 USPQ 458, 459 (CCPA 1963).

Regarding claim 20, Oshefsky includes a turning mechanism capable of rotating at least one transfer assembly before the discrete parts are applied to the substrate.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schroth et al. as applied to claim 1 above, and further in view of Booth et al. (US Patent No. 5,579,340).

Schroth does not discuss a surface roughness for the transfer platens (32) or a plasma coating.

Booth discloses using a transfer segment with an outer surface roughness of at least 3 micrometers. As a result, a relatively low level of vacuum may be drawn through holes in the outer surface (46) to assist the surface roughness in maintaining the elongated elastic parts (26) in the elongated state. To achieve the surface roughness, the outer surface (46) of each transfer

Art Unit: 1734

segment may include a coating such as a plasma coating as are known to those skilled in the art.
(Col. 6, lines 23-53.)

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the platens (32) in Schroth include a surface roughness as taught by Booth, because a surface roughness assists in gripping the article on the surface and thus less vacuum would be needed to hold the article in place. Furthermore, Booth teaches that it is within the purview of the artisan to use a plasma coating to achieve a surface roughness.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sue A. Purvis whose telephone number is 703-305-0507. The examiner can normally be reached on Monday through Friday 8am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rick Crispino can be reached on 703-308-3853. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-1495.



Sue A. Purvis
Examiner
Art Unit 1734

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September 26, 2003